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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,411	12/04/2000	John T. Botti	13117.210	6517
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CLIFFORD CHANCE US LLP 200 PARK AVENUE NEW YORK, NY 10166				
			EXAMINER NGUYEN, CAM LINH T	
			ART UNIT	PAPER NUMBER
			2171	

DATE MAILED: 11/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,411

Applicant(s)

BOTTI ET AL.

Examiner

Cam-Linh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendments to the drawings are acknowledged. Consequently, objection to the drawings is withdrawn.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 60, 66 - 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Mahboud Zabetian (U.S. 6,327,656).

♦ As per claim 1, 23, 41, 43, 45 – 46, 66, 68,

Mahboud Zabetian (U.S. 6,327,656) teaches a method for registering at least one digital file, comprising:

- "Recognizing an occurrence of an event on a computer system" see Fig. 3. "An occurrence of an event" corresponds to a request of certify a electronic document (col. 6 line 14 – 37).
- "In response ... performing a digital signature routine on said at least one digital file to obtain a digital signature of said at least one digital file" Fig. 2A-B, Fig. 3, element 310. Zabetian uses a "Signature generation module 254" in fig. 2B to

extract a signature (step 310 in Fig. 3) (col. 7 line 19 – 25). A digital file corresponds to the document that needs to be certified.

- “Creating a time stamp corresponding to the time of submission of said at least one digital file” See Fig. 2A, element 222. Zabetian uses the clock to determine when the document is submitted (col. 2 line 9 – 15, col. 8 line 61 – 64, col. 9 line 3 - 8).
- “Sending said digital signature and said time stamp to a remote location” See Fig. 3 element 316, col. 4 line 65 – col. 5 line 4, col. 9 line 29 – 65.

Because the Electronic document Certification Application located on the Certification Provider on the server (Fig. 1, Fig. 2A- 2B, col. 4 line 4 – 24), therefore, the user “does not need to perform any act exclusive to the method in order to cause the method to automatically execute”. The system will automatic locate the document if the user is a registered user.

◆ As per claim 2 – 4, 24 – 26, Zabetian discloses:

- “Said occurrence of said event is the execution of a command in a third party software program maintained on said computer system”. “A third party software program” corresponds to a third user that needs to verify the document, or the recipients of a message or a document. See Fig. 1, where the first user can be client 100a, the third party can be clients 100b or 100c. Therefore, “said event is the execution of a command in a third party software program” corresponds to the verification request of a specified number of documents that occurs on the recipients.

- "Said occurrence of said event is the saving of a document in a word processing program" See col. 6 line 16 – 19.
- ◆ As per claim 5 - 6, 27 – 28, Zabetian discloses:
 - "Said occurrence of said event is the passage of a specified amount of time" See col. 2 line 62 – 66. Because the time stamp shows exactly time of day that document submitted, therefore, this will corresponding to the "specified time of day".
- ◆ As per claim 7 - 11, 29 – 33, 47 – 51, Zabetian discloses:
 - "Said at least one digital file is a class of digital files" and "is identified by a filename extension or project designation" See col. 4 line 15 – 20. A digital file in Zabetian can be text, or other types of electronic document and can be located in a floppy disk; a project or a filename is also an electronics document.
- ◆ As per claim 12 - 15, 34 – 37, 52 – 55, Zabetian discloses:
 - "Including the step of receiving a receipt, the receipt including said time stamp, said digital signature, and an identifier of said at least one digital file" See col. 9 line 53 – 65, where the timestamp serial number includes the identify of the document.
- ◆ As per claim 16 - 19, 42, 44, 56 – 59, 67, 69, Zabetian discloses:
 - "Digital signature routine is a checksum routine" See col. 4 line 59 – 60, col. 7 line 30 – 47.
- ◆ As per claim 20, 38, 60, Zabetian discloses:

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- "Event is determined by a function call from a function from a software developer's kit" See Fig. 3, where the function call is determined by the system to verify if the user is registered and located the document.
- ◆ As per claim 21 – 22, 39 – 40, Zabetian discloses:
 - "Said event is an operation modifying a digital file on said computer system" corresponds to the operation of client that wants to verify a document (See col. 5 line 5 – 8). If a newly digital signature found, then the user must have been modified this document.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 61 – 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahboud Zabetian (U.S. 6,327,656) in view of Benjamin J. Renaud (U.S. 6,021,491).

◆ As per claim 61 – 63,

Claims 61 – 63 direct to a method of performing a plurality of signature to a plurality of file, each file will have separate digital signature and time stamp.

Zabetian fails to disclose this function in the invention. However, Renaud, on the other hand, discloses a method to obtain a digital signature for a data streams, that

includes plurality of file, each file has different digital signature and time stamp (See Fig. 3a – 3b, col. 6 line 40 – 64, Renaud).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Renaud into the system of Zabetian, because this operation will reduce the bandwidth in communication between server and client, and since both invention is in the same field.

♦ As per claim 64 - 65, Zabetian discloses:

- “Receiving said second digital file” See Fig. 3 element 302, Zabetian. The second digital file corresponds to the document that needs to be verified.
- “Performing a digital signature routine ... to obtain a second digital signature” See Fig. 4, element 410, Zabetian.
- “Retrieving said digital signature and said time stamp from said database”, and “comparing said second digital signature with said digital signature” See Fig. 4 element 414 – 418., col. 13 line 4 – 16, Zabetian.
- Reporting a result from said comparison” See Fig. 4 element 422, Zabetian.

Response to Arguments

5. Applicant's arguments filed 10/24/2003 have been fully considered but they are not persuasive.

Applicant argues that the Zabetian reference fails to teach a method for registering a digital file that can “recognize an occurrence of an event on a computer system” and “wherein a user on said computer system does not need

to perform any act exclusive to the method in order to cause the method to automatically execute". The Examiner respectfully disagrees.

As stated in the Office Action mailed 04/21/2003, "an event" corresponds to the "command" that a user sends to the server to certify a document. Applicant fails to recognize the breadth of the claims. For instance, the receipt of a request for certificate is clearly an event on a computer system. As seen in Fig. 5, this triggers a response that recognizes the receipt. Therefore, the request or command that is sent from the user is an event that causes the system to response. The operations after receipt the request from the user are performed automatically. The user does not need to perform any act exclusive to the method in order to cause the method to automatically execute (See Fig. 5 element 505 – 525). Clearly, the user does not perform or send other action to the system during this registration process. The Applicant discloses an example of "an event". However, the claims (1, 23, 41, 43, 45, 66, and 68) were not claimed this specifically. "An event" can be applied to any act that occurs on a computer system.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cam-Linh T. Nguyen whose telephone number is 703-305- 1951. The examiner can normally be reached on Monday - Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308- 1436. The fax phone number for the organization where this application or proceeding is assigned is 703- 746- 7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703- 305- 3900.

Cam-Linh Nguyen
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WAYNE AMSBURY
PRIMARY PATENT EXAMINER

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